

### **REMARKS**

Applicants cancel claims 12, 22, and 25-26 and amend claims 13, 24, and 27 such that claims 1-6, 8-10, 13, 15-16, 19, 23-24, 27-30, and 33-34 are pending in this application.

Applicants respectfully request allowance of all the pending claims.

Applicants initially note with appreciation that the Examiner has allowed claims 19 and 23 and identified allowable subject matter in claims 2-6, 26, and 27. In response, Applicants rewrite allowable objected-to claim 26 in independent form as amended independent claim 24 including the limitations of intervening claim 25. Accordingly, claim 24 is allowable. Claim 28 depends from allowable independent claim 24, and is therefore also allowable for these and other reasons.

### **Claim Rejections – 35 U.S.C. §102**

The Examiner rejects claim 13 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 5,967,392 (“Niemi”).

Claim 13 recites a motorcycle saddlebag including an injection-molded body and a lid. The body defines a cavity and includes an integrally-formed body lip defining a mouth of the cavity. The lid includes a lid lip and is movably mounted to the body to open and close the saddlebag. A gasket is positioned on the body lip and is sandwiched between the lid lip and the body lip when the lid is in a closed position. The lid lip includes an undercut, is manufactured separately from the rest of the lid, and is glued to the lid. The lid includes a lid edge and at least one internal gusset. The lid lip is in contact with the gusset and the lid lip undercut is positioned on the lid edge.

Niemi discloses a blow-molded truck utility box (20) including a lid (22) and a storage bin (24). The bin (24) includes a peripheral lip (30) which is reinforced by an aluminum rim (32). The lid (22) includes an integrally-formed peripheral lip (26) (identified as the lid lip by the Examiner). A tubular rubber gasket (44) is bonded to the lid lip (26) and forms a water resistant seal between the lid (22) and the bin (24) when the utility box (20) is closed.

Niemi does not teach or suggest a lid lip that is manufactured separately from the rest of the lid and that is glued to the lid. Instead Niemi discloses a lid lip (26) that is integrally-formed with the lid (22).

In addition, Niemi does not teach or suggest a lid lip having an undercut positioned on the lid edge or a lid lip in contact with an internal gusset on the lid. Rather, Niemi discloses a lid lip (46) that is void of any undercuts. And, Niemi discloses a lid lip (44) that avoids contact with any lid structure that could arguably be considered a gusset.

Therefore, Niemi does not teach or suggest the subject matter defined by independent claim 13. Accordingly, independent claim 13 is allowable. Claims 15 and 16 depend from allowable independent claim 13 and are allowable for the same and other reasons.

#### **Claim Rejections – 35 U.S.C. §103(a)**

The Examiner rejects claims 1, 8-10, 22, 24, 28-30, 33 and 34 under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 2,527,433 (“LaRochelle”) in view of United States Patent No. 5,471,709 (“Lanzani”). LaRochelle discloses a motorcycle saddlebag including a body (19) and a lid (26) connected to the body (19) by a hinge (27). Lanzani discloses a hinge (1) for doors of built-in appliances, for example refrigerators.

In order for the Examiner to rely on Lanzani as a basis for the rejection, Lanzani must either be in the field of endeavor of the claimed invention or, if not, then Lanzani must be reasonably pertinent to the particular problem solved by the claimed invention (see MPEP §2141.01(a)).

Lanzani is non-analogous art because it does not relate to the same art or field of endeavor as the claimed invention. The present invention identified in claims 1, 29, and 33 relates to motorcycle saddlebags and Lanzani relates to built-in appliances. One of ordinary skill in the motorcycle saddlebag art would not look to the art of built-in appliances for a hinge to couple a saddlebag body and lid together.

Further, Lanzani is not reasonably pertinent to the particular problem solved by the present invention. The present invention eliminates localized pinching of the gasket between the lid and the body. As described in the first full paragraph on page 7 of the Application:

Due to the configuration of the hinge assembly 46, as the lid 42 is closed and opened, substantially the entire lid lip 70 respectively engages and disengages substantially the entire gasket 66 instantaneously along the joining perimeter of the saddlebag 34. As a result, there is substantially no localized pinching of the gasket 66 by the lid lip 70 and wear on the lid lip 70 and gasket 66 is significantly reduced.

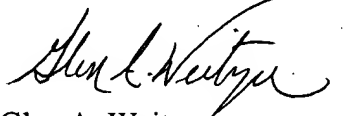
In contrast, Lanzani relates to the problem of avoiding interference between the door (6) of an electrical appliance and the item of furniture enclosing the appliance (see col. 2, lines 13-20).

Therefore, Lanzani is non-analogous art because it does not relate to the same art or field of endeavor and it is not reasonably pertinent to the particular problem solved by the present invention. Applicants respectfully submit that the Examiner has failed to present a *prima facie* case of obviousness of claims 1, 29, and 33 based upon the prior art as required by 35 U.S.C. §103.

Accordingly, claims 1, 29, and 33 are allowable. Claims 2-6 and 8-10 depend from allowable independent claim 1, claim 30 depends from allowable independent claim 29, and claim 34 depends from allowable independent claim 33. Claims 2-6, 8-10, 30, and 34 are allowable for these and other reasons.

The Examiner is invited to contact the undersigned attorney should the Examiner determine that such action would facilitate the prosecution and allowance of the present application.

Respectfully submitted,



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